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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/034,065

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Adam Wayne Mehlberg

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7590

10/05/2004

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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/034,065	<b>Applicant(s)</b> MEHLBERG ET AL.	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/17/04 (Amendment).
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on July 19, 2004. In the amendment  
5 claims 12-14 were canceled; and claims 1, 15, 16, 23, 26, and 29 were amended. Currently,  
claims 1-11 and 15-34 remain for examination.

### *Drawings*

2. The formal drawings were received on July 19, 2004. These drawings are approved and  
10 entered.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

15 The specification shall contain a written description of the invention, and of the manner and process of making  
and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it  
pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode  
contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

20 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the  
subject matter which the applicant regards as his invention.

5. Claims 1-10 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to  
comply with the enablement requirement. The claim(s) contains subject matter which was not  
25 described in the specification in such a way as to enable one skilled in the art to which it pertains,  
or with which it is most nearly connected, to make and/or use the invention.

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Examiner finds the phrase “an attenuation surface to the barcode scanner, wherein attenuation surface is located such that at least one end of scan path .....” is difficult to understand to one ordinary skill in the art, and therefore enable to make and/or use of invention.

In abstract (lines 8-10), it is stated “In one embodiment, the robotic apparatus includes a barcode scanner having a scan path and an attenuation surface within the scanner scan path.”

Attenuation surface within the scanner scan path clearly describes that the attenuation surface is a part of the target, not part of a scanner (see claim 16, 29 etc). However, claims 1 and 15 are written as if attenuation surface is part of the scanner “an attenuation surface affixed to the barcode scanner”

6. Claims 1-10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, line 3: “an attenuation surface affixed to the barcode scanner,” would be incomprehensible to implement in that the attenuation surface reflect lights from a scanner illumination source (see claim 4). Claim 15 is rejected on the same ground.

7. Claims 2-10 are rejected under U.S.C. 112, first/second paragraph as being dependent claims of claim 1.

***. Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 16, 20-23, 26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by

5 Rockwell et al. (US 6,138,909, "Rockwell" hereinafter).

Re claims 16, 20, 22, 23, 26, and 29, Rockwell teaches a robot (see figure 1; col. 1, lines 26+) comprising a gripper 22, a barcode scanner 26 providing a scan path which scans a barcode 28 affixed to the data cartridge processor 14 (col. 2, lines 35+), wherein the positional parameters are retrieved from the barcode (col. 3, lines 35+). Since the barcode is affixed on the surface of  
10 the cartridge processor 14, it can be said that the surface contributes in determining the scan path.

Re claims 13 and 21, as shown in figure 1, scanning direction is horizontal and the robot/gripper can move vertically and horizontally if multiple storage racks are used (col. 2, lines 48+).

15 ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the  
25 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 17-19, 24, 25, 27, 28, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockwell et al. (US 6,138,909).

5        Claims 17-19, the material used in manufacturing the storage rack 18 can be used to make the rack comprising sharp edges – In fact, border area of each tray compartment 20 create sharp edges. Although Rockwell does not explicitly suggest that the surface is beveled, such feature is a design consideration. One ordinary skill in the art would choose to design the surface however he/she wants as long as the barcode can be applied and functions as intended.

10        Re claims 24, 25, 27, 28, and 30-34, as shown in figure 3, the robot retrieves/deposits a data cartridge relying on positioning the device according to offset value 44, and 45 from the (col. 3, lines 35+). Location of the left edge 46 is stored along with the barcode information (col. 3, lines 49+). Although not explicitly suggested, it is obvious to one ordinary skill in the art to store location of right edge, or calculate center/mid point using locations of right and left edges.

15

### ***Response to Remarks***

13. Amended claims and remarks filed on July 19, 2004 have been carefully reviewed and considered.

Applicant directed the Examiner to the specification (from page 11, line 26 – page 14,  
20 line 2) for 112 second paragraph rejection. Examiner reviewed the section again. As indicated in previous Office Action, “attenuation surface” is only mentioned in the summary of the invention section (line 8). Examiner respectfully submits that context of “attenuation surface” in

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the summary of invention is that attenuation surface is within the scanner scan path. Relying on figure 3, the scanner appears to be a part of the camera system 360, and the calibration target is 300 affixed to a surface. Accordingly, it can not be contemplated “an attenuation surface affixed to the barcode scanner” in implementing what is claimed.

5 As indicated in paragraphs 9 and 12 above, it is the Examiner’s view that the Rockwell patent discloses the subject matter disclosed in presented claims. Therefore, the Examiner has made this Office Action final.

#### *Additional Remarks*

10 14. Re claims 1-10, and 15, the lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though claims 1-10, 15 are rewritten or amended to overcome the rejection under 35 U.S.C. 112 in paragraphs 5 and 6 above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15 A shortened statutory period for reply to this final action is set to expire THREE  
20 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 30, 2004

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